

REMARKS

Status of the Claims

Claims 50, 51, 54, 55, and 64 are amended, claims 72-81 are added, and claims 56-63 and 65-69 are cancelled without prejudice to future prosecution. Therefore, with entry of this amendment, claims 49-55, 64, and 70-81 are pending. Claim 64 has been rewritten in independent form and amended to explicitly recite the compounds of Fig. 1. Claims 50 and 51 have been amended to correct typographical errors. Claim 54 has been amended to limit the definition of R⁵ and R⁶.

As discussed with the Examiner on February 8, 2005, new claims 72-81 are directed to compound claims that are identical in scope to the compounds encompassed by the compositions of claims 49-55, 64, and 70-71. Therefore, Applicants respectfully request entry of new claims 72-81.

In light of the above remarks, Applicants respectfully submit that no new matter is added with this amendment.

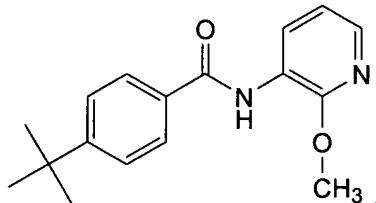
The Rejections

Claims 50, 51, 63, and 64 stand rejected under 35 U.S.C. § 112, second paragraph for failing to recite "method" instead of "composition" in claims 50, 51, and 63, and for referring to "Fig. 1" in claim 64. The claims have been amended to correct the defects. Applicants thank the Examiner for pointing out these errors.

Claims 54 and 65 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Boehringer Mannheim GmbH (Reference AM). Claims 55 and 66-69 are objected to as dependent upon rejected base claims. The Examiner asserts that the recitation of "4-(1,1-Dimethylethyl)-N-(2-methoxy-3-pyridinyl)benzamid [sic]" at page 8, line 8 clearly anticipates claims 54 and 65.

As a preliminary matter, Applicants note that claims 65-69 have been cancelled, thus mooting the rejection with respect to those claims.

With respect to the Examiner's rejection of claim 54 under 35 U.S.C § 102(b), Applicants respectfully disagree. The named compound disclosed in Reference AM contains a methoxy at the ortho position of the pyridinyl moiety, as shown in the structure below:



In contrast, claim 54 encompasses only those benzanilides having a pyridinyl moiety substituted at the para position with the substituent Y.

Nonetheless, to expedite prosecution, Applicants have amended claim 54 by limiting the definition of R⁵ and R⁶. Therefore, Applicants respectfully request withdrawal of the rejection.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6100.

Respectfully submitted,

Kenneth E. Jenkins, Ph.D.
Reg. No. 51,846

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300
Attachments
KEJ:kej:jcf
60398259 v1